

REMARKS

Claims 1-15 were pending in this application. Claims 1, 12, and 13 (only as drawn to SEQ ID NO: 13), 7-11 and 15 were withdrawn by the Examiner. Claims 3-11 and 13 are canceled herein and claims 1 and 12 are amended herein. New claims 16 and 17 are added herein. Applicants reserve the right to pursue any canceled subject matter at a later time.

Support for the amendment of claim 12 can be found in original claim 13. Support for new claims 16 and 17 can be found in the specification at least at page 15, lines 8-17.

No new matter is introduced by these amendments. Unless specifically stated otherwise, none of these amendments is intended to limit the scope of any claim.

After entry of this amendment, claims 1, 2, 12, 14, 16, and 17 are pending.
Consideration and allowance of the pending claims is requested.

Restriction Requirement:

Applicants acknowledge that the election of Group I (claims 1, 12, and 13 only as directed to SEQ ID NO: 2, 2-6, and 14) is made final. The claims of Group II (claims 1, 12, and 13 only as directed to SEQ ID NO: 13, 7-11, and 15) are canceled.

Examiner Interviews:

Applicants thank Examiner Garvey for the courtesy of the telephone interviews with their representative Dr. Anne Carlson on November 4, 2004. During the interviews, the rejection of the claims 1-6, 12, and 13 under 35 U.S.C. §112, first paragraph were discussed. Proposed amendments to the claims, in particular amendments to change the percent identity of SEQ ID NO: 2 homologs encompassed by the claims, were discussed during the interview.

Applicants' representative pointed out support in the specification for homologs having similar ELF3 protein biological activity and that claims to nucleic acid sequences encoding a protein comprising 95% sequence identity to SEQ ID NO: 2 were allowed in the parent case (U.S. Patent No. 6,689,940). Examiner Garvey stated that, in light of the support in the

specification and the scope of the allowed claims in the parent case, she would consider allowing claims directed to amino acid sequences having at least 95% sequence identity to SEQ ID NO: 2. Though agreement as to all matters was not reached, it is believed that this Amendment and Response is in accordance with the interviews.

Claim Rejections Under 35 U.S.C. §112, first paragraph:

Claims 1-6, 12, and 13

Claims 1-6, 12, and 13 have been rejected under 35 U.S.C. §112, first paragraph because the claims allegedly contain subject matter that was not described in the specification in such a way as to enable one of skill in the art to make or use the invention. Applicants respectfully traverse this rejection.

Claims 3-6 and 13 have been canceled, rendering the rejection of these claims moot.

The Office action states that the specification teaches homologs of SEQ ID NO: 2, but does not describe the percent identity to the claimed amino acid sequence or show the biological activity exhibited by these homologs. Applicants submit that the specification at least at page 14, lines 6-24, describes homologs of the ELF3 protein having at least 91% sequence identity and having ELF3 protein biological activity. However, solely in the interest of advancing prosecution in the current application, Applicants have amended claim 1 to be directed to “(a) the amino acid sequence of SEQ ID NO: 2; and (b) amino acid sequences having at least 95% sequence identity to the sequences specified in (a).” Claims 2 and 12 depend from claim 1 and incorporate all of the limitations thereof. Applicants respectfully request that this rejection of claims 1, 2, and 12 be withdrawn.

Claim 12


Claim 12 has been rejected under 35 U.S.C. §112, first paragraph because the claim allegedly fails to comply with the written description requirement because the specification does not describe the structure of all possible binding agents that could be bound to ELF3. Solely in the interest of advancing prosecution in the current application, Applicants have amended claim 12 to refer specifically to an anti-ELF3 protein antibody. Applicants respectfully request that this rejection of claim 12 be withdrawn.

CONCLUSION

Based on the foregoing amendments and arguments, the claims are in condition for allowance and notification to this effect is requested. If for any reason the Examiner believes that a telephone conference would expedite allowance of these claims, please telephone the undersigned at (503) 226-7391.

Respectfully submitted,

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